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Carol Ann

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EXAMINER

NGUYEN, TAN D

ART UNIT

PAPER NUMBER

3689

NOTIFICATION DATE DELIVERY MODE

06/29/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOmail@hsm1.com  
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<b>Office Action Summary</b>	<b>Application No.</b> 09/887,781	<b>Applicant(s)</b> ANN ET AL.	
	<b>Examiner</b> Tan Dean D. Nguyen	<b>Art Unit</b> 3689	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on 26 February 2009.

2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 1, 2, 4, 6, 9, 10, 13-23, 26, 27, 29 and 30 is/are pending in the application.

    4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1, 2, 4, 6, 9, 10, 13-23, 26, 27, 29 and 30 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All    b) ☐ Some \*    c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
    Paper No(s)/Mail Date \_\_\_\_\_.

4) ☐ Interview Summary (PTO-413)  
    Paper No(s)/Mail Date \_\_\_\_\_.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***I. Response to Amendment***

1. The amendment of 2/26/09 has been entered.

### ***II. Claim Status***

2. Claims 1-2, 4, 6, 9-10 and 13-23, 26-27, and 29-30 are pending. Claim 3, 5, 7-8, 11-12, 20, 24-25 and 28 have been canceled. They comprise 3 groups:

1) system<sup>1</sup>: 1 -2, 4, 6, 18-23, 26-27 and 29,

2) method: 9-10, 13-17, and

3) system<sup>2</sup>: 30.

### ***III. Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 9-10, 13-17 (method) are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. An example of a method claim that would not

qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

With respect to claims 9-10 and 13-17, the claim language (body of claim 1) does not include the required (1) tie to a particular machine or (2) transformation of the underlying subject matter, and thus is directed to nonstatutory subject matter. Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be performed without the use of a particular apparatus. Thus, claims 9-10 and 13-17 do not positively recite another statutory class to which the method steps are tied and therefore are non-statutory.

Applicant's amendment of the claim to include the tie to a computer in the preamble is noted, however, the preamble is normally considered as "optional" or "capable of" and does not carry much patentable weight. Insertion of the "tie" limitation to the body of the claim or method steps are required to overcome the rejection.

5. Claims 1-2, 4, 6, 18-23, 26-27 and 29, and 30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to more than one class of statutory subject matter.

The independent claim 1 begins by discussing "A computer **system**" (Apparatus) but the body of the claims contains method steps such as:

- a) "providing one or more relationship",
- b) "providing one or more relationship",
- c) "guiding the user to access and change or more of the section component",
- d) "that determines how a change...", and
- e) "that outputs the results...",

or language that is used in the claims of a process. "A claim of this type is precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only". See Ex parte Lyell (17 USPQ2d 1548).

Similarly, the independent claim 30 begins by discussing "An Enterprise **system**" (Apparatus) but the body of the claims contains method steps such as:

- a) "to process business information which the enterprise uses to conduct.."
- b) "a navigator... for using and modifying...",
- d) "a reference component component ... customized for the business..."
- e) "listing business locations..."
- f) "using products and standards ...."

g) "a linkage assessment tool that evaluates the operational linkages....assessing the impact ...and outputs an impact ..."

or language that is used in the claims of a process. "A claim of this type is precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only". See Ex parte Lyell (17 USPQ2d 1548).

**6. Claims 1-2, 4, 6, 18-23, 26-27, 29 (system), 9-10, 13-17 (method), and 30 (system) are rejected under 35 U.S.C. 103(a) as being unpatentable over HUANG et al (US 6,151,582) in view of Applicant Admitted Prior Art (AAPA).**

As of 2/26/09, Claim 1 is as followed:

1. (Currently Amended) A computer system to model a business enterprise and its information technology, comprising:

- a) at least one computer processing unit;
- b) at least one memory connected to at least one computer processing unit;
- c) an integrated enterprise component representing the business enterprise and comprising a business component integrated and operationally linked with an information technology component, the components stored in at least one computer memory and accessible by at least one computer processing unit;
- d) the business component further comprising a plurality of business section operationally integrated providing one or more relationships with at least one other business section component;

d) the information technology component further comprising at least one application software component processing at least business information data from the business component, and a plurality of information technology section components operationally integrated providing one or more relationships with at least one other information technology section component;

e) a guiding component accessible to a user for guiding the user to access and change one or more of the section components;

f) an assessment tool component that determines how a change in one section component effects the relationships with others of the section components; and

g) an impact assessment work product generated by at least one computer processing unit that outputs the results of the assessment component.

Note: independent claim 1 is (appears to be) an apparatus claim. In examination of the apparatus claim, the claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See (1) MPEP 2114. (2) *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Apparatus claims cover what a device is, not what a device does, i.e. "device which acts or performs ...". (3) *Hewlett-Packard Co. vs. Bausch & Lomb Inc.* (Fed. Circ. 1990). Manner of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed

apparatus is intended to be employed/used, does not differentiate apparatus from the prior art apparatus. (4) *Ex parte Masham*, 2 USPQ2d 1647 (BPAI, 1987).

Also, this is an apparatus claim and intended use limitation for the system/device or apparatus, i.e. “to model ...technology” in the preamble carries no patentable weight.

It is first important to note that the use of the term “component” leaves open to interpretation whether “component” is a device or a software component. *See In re Comiskey*, 499 F.3d 1365, at 1379 (Fed. Cir. 2007). Since the “components” being stored in at least one computer memory, this indicates that the “components” are software components.

However, current claim 1 only describes each of the different component using functional language, i.e.,

“an integrated interprise component representing the business enterprise...”,

“ a guiding component accessible to a user for guiding the user to access and change ...”,

“component that determines..” and

“an impact assessment work product generated by at least... that outputs the results”,

without tying such descriptions to positive claim language, such as produced when one uses the term “configured” or, even more positively, 35 U.S.C. 112, sixth paragraph language. Unlike the machine claim in *Prater* which used means plus function language to describe its device, *see Prater* at 1397-1398, Current claim 1 does not use such language, and thus should not be



given the same interpretation of the machine claim in *Prater*. To do so would be to dilute the provisions of the statute. However, although Appellants' language is functional, we are nevertheless required to give the language weight to the extent that the prior art is or is not capable of meeting the functional limitation. See *In re Schreiber*, 128 F.3d 1473 (Fed. Cir. 1997). Note that the last element "an impact assessment work product" is not even an apparatus element or structure.

As for independent system claim 1, similarly, HUANG et al discloses an enterprise system for modeling the operation of a business enterprise and determining the impact how a change in one section component effects the entire (whole) business system or the relationships with others of the sections components, the system comprising:

A computer system to model a business enterprise and its information technology, comprising:

- a) at least one computer processing unit;
- b) at least one memory connected to at least one computer processing unit;
- c) an integrated enterprise component representing the business enterprise and comprising a business component integrated and operationally linked with a business sub component, the components stored in at least one computer memory and accessible by at least one computer processing unit;

d) the business component further comprising a plurality of business section operationally integrated providing one or more relationships with at least one other business section component;

d) the business sub component further comprising at least one application software component processing at least business information data from the business component, and a plurality of business section sub components operationally integrated providing one or more relationships with at least one other business sub-section component;

e) a guiding component accessible to a user for guiding the user to access and change one or more of the section components;

f) an assessment tool component that determines how a change in one section component effects the relationships with others of the section components; and

g) an impact assessment work product generated by at least one computer processing unit that outputs the results of the assessment component.

{see Figs. 1, 2, 4, 34, 35, 37, especially **41**, and cols. 1-2, 91-92, "...*dynamically monitors the impact of the user's decisions on the performance of the entire supply chain by using supply chain simulation*", cols. 106-107 and 111-112.}

HUANG et al fairly teaches the claimed invention except for the difference in the business sub-component, i.e. an information technology (IT) component (architecture).

AAPA, as shown on Figs. 1-2 ("PRIOR ART"), or applicant's specification, under "Background Art" disclosing well known modeling of a business model and its IT modeling in two separate and unconnected systems and the proposal changing in the IT model (component) are defined in isolation and does not reflect the total impact of the business enterprise (model).

Therefore, it would have been obvious to a person having ordinary skill in the art (herein after as "PHOSITA") at the time of the invention was made to modify the type of sub-business component system and method of HUANG et al to (IT) component as taught by AAPA, as mere using other well known sub-business component that current have the same issues that requires an answer as taught in HUANG et al, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Following KSR, the Supreme Court issued several rationales for supporting a conclusion that a claim would have been obvious. If a particular known technique was recognized as part of the ordinary capabilities of one skilled in the art, and one of ordinary skill in the art would have been capable of applying this known technique to a known device (method, or product) and the results would have been predictable to one of ordinary skill in the art; then the claim will be deemed obvious in view of the prior art.

As for dep. claims 2, 4 (part of 9 above) which deal with an element/item for accessing the data for changing/modifying business element, this is taught in HUANG et al /AAPA as shown in HUANG et al Figs. . 1, 2, 4, 34, 35, 37, especially **41**, and cols. 1-2, 91-92, "...dynamically **monitors the impact** of the user's decisions on **the**

***performance of the entire supply chain by using supply chain simulation***", cols. 106-107 and 111-112.}

As for dep. claims 6, 18-23, 26-27, 29, which deal with architecture (organization structures) parameters for the business enterprise and the information technology, these are fairly taught in Figs. 1, 2 of AAPA and HUANG et al Figs. 2, -4, 7, 9. 34-35, 41 and cols. 1-2 and 91-92. Moreover, these terms or structures appear to be non-functional in a data processing system.

**As for independent claims 9 and system claim 30**, which appear to be the method claim and system claim to carry out the independent article claim 1 above, they are rejected over the article/computer program product claim of HUANG et al / AAPA as shown on Figs. 1-2, and 41 of HUANG et al. .

As for dep. claims 10 and 13-17 (part of 9 above), which appear to have the same limitations as in dep. claims 2, 4, 6, 18-23 and 26 (part of 1 above), they are rejected for the same reasons set forth above.

### ***Response to Arguments***

7. Applicant's arguments with respect to the previous rejections have been considered but are moot in view of the new ground(s) of rejection which are due to applicant's amendment.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1) US 2002/0133368, by STRUTT et al fairly discloses similar teachings to BOWMAN-AMUAH, and is cited here for applicants' awareness of potential use in the future if needed to avoid duplicate rejections.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

No claims are allowed.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail [CustomerService3600@uspto.gov](mailto:CustomerService3600@uspto.gov).

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor Janice Mooneyham can be reached at (571) 272-6805.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

/Tan Dean D. Nguyen/  
Primary Examiner, Art Unit 3689